



PATENT

Docket No.: 176/60930 (2-11150-984)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants : David P. Biss, Thomas G. Brown, and
Kathleen S. Youngworth
Serial No. : 09/759,913
Cnfrm. No. : 2814
Filed : January 12, 2001
For : AN APPARATUS FOR PRODUCTION OF
INHOMOGENEOUSLY POLARIZED
OPTICAL BEAMS FOR USE IN
ILLUMINATION AND A METHOD
THEREOF

Examiner:
R.D. Shafer

Art Unit:
2872

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10/10/03

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RESPONSE TO RESTRICTION REQUIREMENT

Mail Stop:
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In response to the Restriction Requirement dated May 20, 2003, Applicants hereby provisionally elect the species of FIG. 1 within Invention II for a microscope and a method for microscopic scanning as set forth in claims 62-66 and claims 77-81, respectively, with traverse.

The Office has withdrawn the prior restriction requirements and has issued a new restriction requirement restricting claims 1-87 into Invention I containing claims 1-61 and drawn to an apparatus and method for producing an inhomogeneously polarized optical beam from a homogeneously polarized input optical beam, classified in class 359, subclass 495, and Invention II containing claims 62-87 and drawn to a microscope and a method for microscopic scanning, classified in class 359, subclass 368. The Office asserts that Inventions I and II are related to each other as a sub-combination and combination, respectively, and that Inventions I and II have acquired a separate status in the art as shown

by their different search classifications. Further, the Office asserts that each of Inventions I and II contain claims directed to patentably distinct species of the claimed inventions corresponding to FIGS. 1, 2 and 3.

Applicant respectfully directs the Office's attention to M.P.E.P. § 803, which provides "[i]f the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits ..." The Office notes that class 359, subclass 368 must be searched for claims 62-66 and 77-81 belonging to Invention II. Applicants submits, however, that any search which must be conducted in class 359, subclass 368 in connection with the examination of claims 62-66 and 77-81 would also allow the Office to examine claims 1-9 and 19-32 from Invention I without imposing any undue burden upon the Office since claims 1-9, 62-66, 19-32 and 77-81 all read on the disclosed species illustrated by FIG. 1. Accordingly, the Office is requested to reconsider the outstanding Restriction Requirement and examine claims 1-9, 19-32, 62-66 and 77-81 together.


Additionally, Applicants respectfully request the Office to consider rejoining claims 67-76 and 82-87 from Invention II, which read on the unelected species of polarization converters depicted by FIGS. 2 and 3, upon the determination that claims 62 and 77 are allowable. The Office is also requested to rejoin claims 1-61 from Invention I which read on the unelected species of polarization converters depicted by FIGS. 1, 2, and 3 upon the determination that claims 62 and 77 are allowable.

Applicants believe the above-identified application is in condition for allowance, and such allowance is earnestly solicited.

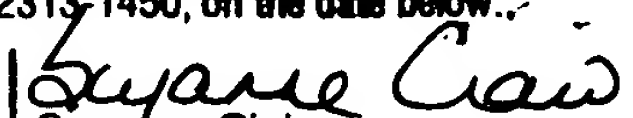
Respectfully submitted,

Date: June 18, 2003

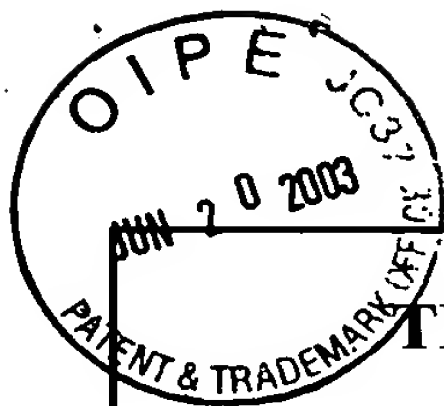
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| Certificate of Mailing - 37 CFR 1.8(a) | |
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| 6-18-03 Date |  Suzanne Ciaio |

2872



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|---|---|------------------------|-------------------------|
| TRANSMITTAL FORM (to be used for all correspondence after initial filing) | | Application Number | 09/759,913 |
| | | Filing Date | January 12, 2001 |
| | | First Named Inventor | David P. Biss |
| | | Group Art Unit | 2872 |
| | | Examiner Name | R.D. Shafer |
| Total Number of Pages in This Submission | 3 | Attorney Docket Number | 176/60930 (2-11150-984) |

| ENCLOSURES (check all that apply) | | |
|--|---|--|
| <input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 | <input type="checkbox"/> Assignment Papers (for an Application) <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Declaration and Power of Attorney <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ | <input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Application Data Sheet <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): RESPONSE TO RESTRICTION REQUIREMENT |
| Remarks | | <input checked="" type="checkbox"/> The Commissioner is hereby authorized to charge any additional fees required or credit any overpayments to Deposit Account No. 14-1138 for the above identified docket number. |

| SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT | |
|--|---|
| Firm or Individual name | John Campa Nixon Peabody LLP Clinton Square, P.O. Box 31051 Rochester, New York 14603-1051 Telephone: (585) 263-1519 Fax: (585) 263-1600 |
| Signature | <i>John Campa</i> |
| Date | June 18, 2003 |

| CERTIFICATE OF MAILING OR TRANSMISSION [37 CFR 1.8(a)] | |
|---|----------------------|
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| Signature: | <i>Suzanne Ciaio</i> |
| Name: | Suzanne Ciaio |

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